

REMARKS

This application contains claims 1-48. Claims 1, 17 and 33 are hereby amended. No new matter has been introduced. Reconsideration is respectfully requested.

Applicant thanks Examiners Hashemi and Colan for the courtesy of a personal interview with Applicant's representative, Sanford T. Colb (Reg. No. 26,856), held in the USPTO on June 6, 2007. At the interview, Mr. Colb presented a draft amendment to claim 1 and explained the distinction of the claimed invention over the cited art. The Examiners agreed that this amendment would overcome the outstanding rejections. The independent claims have accordingly been amended as proposed at the interview.

Claim 17 as filed in the previous amendment in this case was incorrectly labeled as "Original," rather than "Currently amended." The labeling has been corrected in the present amendment.

Claims 1-10, 15, 17-19, 22-26, 33-35 and 38-42 were rejected for obviousness-type double patenting over U.S. Patent 7,089,384. Applicant submits herewith a terminal disclaimer with respect to this patent. The double patenting rejection should accordingly be withdrawn.

Claims 1-48 were rejected under 35 U.S.C. 112, second paragraph, for lack of clarity in the term "expected" and in certain other phrases. Applicant has amended independent claims 1, 17 and 33, as agreed in the interview, to clarify that the expected locations are indicated by a predetermined prediction algorithm based on the locations to which the data have already been written. Specific algorithms of this sort are described in detail in the specification in paragraphs 0049-0051, for example. Applicant has also modified the phrasing of the "updating" and "outputting" steps in order to resolve the other points that the Examiner considered to be unclear or indefinite. In view of these amendments, as

indicated by the Examiners in the interview, all of the claims in this application are now believed to meet the requirements of 35 U.S.C. 112.

Claims 1-48 were rejected under 35 U.S.C. 101, on the grounds that claims 1 and 17 merely recite computing steps without a tangible result, and because it was not clear to the Examiner what the "signal" recited in claim 17 comprises, and on the grounds that claim 33 is directed to software *per se*. Applicant has amended claims 1, 17 and 33 to recite the tangible result of "outputting an acknowledgement," rather than "signaling." Claim 33 is not directed to software *per se*, but rather to "A computer software product... comprising a computer-readable medium in which program instructions are stored..." in the accepted Beauregard form. Thus, as agreed in the interview, all of the claims in this application are now believed to meet the requirements of 35 U.S.C. 101.

Claims 1-48 were rejected under 35 U.S.C. 103(a) over Black (US 6,978,324) in view of Bakke et al. (US 2003/0023808). The above-mentioned amendments to independent claims 1, 17 and 33 clarify the distinction of the present invention over the cited art.

Claim 1, as amended, recites a method for data storage management that uses a record of locations to which the host processor is expected to write data in managing data backup to a secondary storage subsystem. These expected write locations are indicated by a predetermined prediction algorithm based on the locations to which the data have already been written. The cited references neither teach nor suggest any sort of prediction of write locations, let alone the use of a prediction algorithm in maintaining a record of locations to which data are expected to be written based on the locations to which the data have already been written, as recited in amended claim 1.

Therefore, Applicant respectfully submits that claim 1, as amended, is patentable over the cited art. In view of the patentability of claim 1, dependent claims 2-16 are also believed to be patentable.

Claims 17-48 recite apparatus and computer software products that operate on principles similar to the methods of claims 1-16. Independent claims 17 and 33 have been amended in like manner to claim 1. Therefore, for the reasons explained above, claims 17-48 are believed to be patentable, as well.

Notwithstanding the patentability of the independent claims in this application, the dependent claims are also believed to recite independently-patentable subject matter. For the sake of brevity, however, Applicant will refrain from arguing the independent patentability of the dependent claims at present.

Applicant has studied the additional references made of record by the Examiner and believes the claims in this application to be patentable over these additional references, as well.

Applicant believes the amendments and remarks presented hereinabove to be fully responsive to all of the grounds of rejection raised by the Examiner. In view of these amendments and remarks, Applicant respectfully submits that all of the claims in the present application are in order for allowance. Notice to this effect is hereby requested.

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Respectfully submitted,

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